IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
Before the Board of Patent Appeals and Interferences

In re Patent Application of
GREENAWAY et al
Serial No. 09/622,405
Filed: August 17, 2000
Title: THREE DIMENSIONAL IMAGING SYSTEM

Atty Dkt. 124-786
C# M#
Group Art Unit: 2872
Examiner: A. Amari
Date: September 15, 2003

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

☐ **Correspondence Address Indication Form Attached.**

☐ **NOTICE OF APPEAL** Applicant hereby appeals to the Board of Appeals from the decision dated _____ of the Examiner twice/finally rejecting claims _____ ($ 320.00)	$	
☐ An appeal **BRIEF** is attached in triplicate in the pending appeal of the above-identified application ($)	$	
☐ Credit for fees paid in prior appeal without decision on merits	-$ ( )	
☒ A reply brief is attached in triplicate under Rule 193(b)		**(no fee)**
☐ Petition is hereby made to extend the current due date so as to cover the filing date of this paper and attachment(s) (**$110.00/1 month**; $410.00/2 months; **$930.00/3 months**; $1450.00/4 months)	$	
	SUBTOTAL $	0.00
☐ Applicant claims "Small entity" status, enter ½ of subtotal and subtract ☐ "Small entity" statement attached.	-$( )	
	SUBTOTAL $	0.00
Less month extension previously paid on	-$(	0.00)
	TOTAL FEE ENCLOSED $	0.00

Any future submission requiring an extension of time is hereby stated to include a petition for such time extension. The Commissioner is hereby authorized to charge any deficiency, or credit any overpayment, in the fee(s) filed, or asserted to be filed, or which should have been filed herewith (or with any paper hereafter filed in this application by this firm) to our **Account No. 14-1140.** A duplicate copy of this sheet is attached.

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NIXON & VANDERHYE P.C.
By Atty: Stanley C. Spooner, Reg. No. 27,393

Signature: _____

There is no legal citation as support for this contention, and, in making this argument, the Examiner has ignored his own cited precedent set out by the Court of Appeals for the Federal Circuit in the *In re Fine* case which states that it is "error to find obviousness where references 'diverge from and teach away from the invention at hand'." *In re Fine* at 1599.

As pointed out in appellants' Appeal Brief, both the Kubo and Shimano references would lead one of ordinary skill in the art away from appellants' claimed combination of elements. The Examiner has failed to deny that each of these references would lead one of ordinary skill in the art away from the combination. The Examiner's attempt to establish a new legal theory of obviousness fails, because it is unsupported by any decision of the Board of Patent Appeals and Interferences or the Court of Appeals for the Federal Circuit.

CONCLUSION

The Examiner's Answer attempts to divert the Board's attention by reference to outdated case law away from the glaring fact that no prior art reference teaches structures which are positively recited in appellants' independent claims, i.e. the "producing simultaneously a plurality of spatially separated images from a plurality of object planes" and the specified "diffraction grating." Further, the Examiner fails to respond to the requirements of the Court of Appeals for the Federal Circuit (set out in its more recent decisions) governing how the Patent Office must meet its burden of establishing a *prima facie* case of obviousness. The examiner ignores the requirement that be some motivation or reason for combining the references in the manner of appellants' claims.

Finally, the Examiner propounds a new legal theory that, in spite of the failure to deny that the prior art teaches away from the claimed invention, there is now some burden on the part of an applicant to provide arguments as to why the Examiner's proposed combination (whether or not it discloses the elements set out in the claims and whether or not there is any reason for combining the references and whether or not the references have bear any relationship to the problem solved by the claimed invention) that the proposed combination would render the prior art unsatisfactory for its intended purpose. There is simply no legal support for the Examiner's contention.

Thus, and in view of the above, the rejection of claims 1-4, 6-8, 10-12, 15-18, 20 and 21 over the cited prior art is clearly in error and reversal thereof by this Honorable Board is respectfully requested.

Respectfully submitted,

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